

**Appl. No.** : 10/821,667  
**Filed** : April 9, 2004

#### REMARKS

Applicants have amended Claims 1-4 and 26 and added new Claim 33. Support for the compounds recited in the new claim can be found in Example 1, therefore no new subject matter has been added. Claims 1-4 and 5-33 are now pending, of which Claims 5-25 and 27-32 are withdrawn.

#### Rejections Under 35 U.S.C. §112

The Examiner rejected Claims 1-4 and 26 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claim 1 was amended to correct the lack of antecedent basis for "said substituents". Applicants have also amended Claim 26 to delete the phrase "Genera 1-4, preferred substituents for R<sub>1</sub> and R<sub>2</sub> are selected from," and to add an "and" before substituent 19 and a period at the end of the claim. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of Claims 1-4 and 26.

#### Rejections Under 35 U.S.C. §102(b)

The Examiner rejected Claims 1-3 and 26 under 35 U.S.C. §102(b) as being anticipated by Tanaka et al. (JP 06-263993), Masukawa et al. (U.S. Patent 5,017,468) and Manecke et al. (Makromolekulare Chemie (1975), 176(12), pages 3551-63). According to the Examiner, each of the above cited prior art references discloses at least one compound that is embraced by the claimed invention. Applicants have amended Claim 1 to recite "wherein R<sub>1</sub> and R<sub>2</sub> are not both methyl or phenyl" and deleted NHCOR' as a substituent; therefore, the above prior art references do not anticipate Claim 1 as amended. Since Claims 2-4 and 26 depends from Claim 1 and recite additional limitations, Claims 2-4 and 26 are not anticipated by the above prior art references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of Claims 1-4 and 26.

#### Rejections Under 35 U.S.C. §103(a)

The Examiner rejected Claims 1-3 and 26 under 35 U.S.C. §103(a) as being obvious over Masukawa et al. (U.S. Patent 5,017,468) and Ninomiya et al. (EP 353,606). According to the

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Examiner, Masukawa et al. and Ninomiya et al. each teach imidazole compounds that are either structurally the same as or structurally similar to the claimed compounds.

Applicants respectfully assert that the claimed invention is not obvious in view of either Masukawa et al. or Ninomiya et al. because the claimed invention recites compounds that possess unexpected activity as IgE antagonists. By contrast, Masukawa or Ninomiya disclose imidazole type ring compounds and their use as photographic material and non-linear optical material, respectively. There is no suggestion in either reference that the imidazole type ring compounds possess anti-allergic/anti-asthma activity by virtue of their ability to suppress IgE. A *prima facie* case of obviousness based on structural similarity alone is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

Because, "from the standpoint of patent law, a compound and its properties are inseparable", Applicant respectfully asserts that the pharmacological properties (i.e. anti-allergic/anti-asthma) of Applicant's invention render the present invention unobvious in light of Masukawa and Ninomiya. *In re Papesch*, 315 F.2d 381, 391 (CCPA 1963). Accordingly, even assuming that the chemical structures in the present invention are suggested by Masukawa or Ninomiya, which they are not, Applicant respectfully asserts that patentability should not be determined on the basis of the obviousness of structures alone. See 315 F.2d at 391 (The failure to take into consideration the biological or pharmaceutical property of compounds on the ground that the structure of the compounds would be obvious to chemists is an error of law).

Accordingly, Applicants respectfully request that the Examiner withdraw the objections under 35 U.S.C. § 103(a).

#### CONCLUSIONS

In view of the remarks set forth above, Applicants respectfully submit that Claims 1-4 and 26 in this application are now in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully invited to contact the undersigned at telephone number appearing below. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

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Respectfully submitted,

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Dated: \_\_\_\_\_

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